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TO: Commissioner for Patents   FROM: Jason S. Feldmar
       Attn: Examiner Alina A. Boutah   OUR REF.:   G&C 30566.112-US-U1
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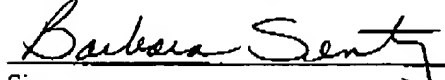| Title of Document Transmitted:	TRANSMITTAL SHEETS AND REPLY BRIEF OF APPELLANTS.
Applicant:	Howard Marantz et al.
Serial No.:	09/629,117
Filed:	July 31, 2000
Group Art Unit:	2143
Title:	METHOD AND APPARATUS FOR OBTAINING A SET OF MAPS
Our Ref. No.:	G&C 30566.112-US-U1

Please charge all fees to Deposit Account No. 50-0494 of Gates & Cooper LLP.

By: _____

Name: Jason S. Feldmar
Reg. No.: 39,187

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Due Date: March 25, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
	)	
Inventor: Howard Marantz et al.	)	Examiner: Alina A. Boutah
	)	
Serial #: 09/629,117	)	Group Art Unit: 2143
	)	
Filed: July 31, 2000	)	Appeal No.: _____
	)	
Title: METHOD AND APPARATUS FOR	)	
OBTAINING A SET OF MAPS	)	

REPLY BRIEF OF APPELLANTS

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR §41.41, Appellants hereby submit the Appellants' Reply Brief to the Examiner's Answer dated January 25, 2006.

No fees are due at this time. However, please charge any additional fees or credit any overpayments to Deposit Account No. 50-0494 of Gates & Cooper LLP.

I.   RESPONSE TO EXAMINER'S ARGUMENTS

A.   Independent Claims 11, 23, and 35

In response to the prior arguments submitted by the Appellants, the Answer merely reasserts the prior rejections.

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Appellants respectfully traverse the above assertions. There are at least two explicitly claimed components for the mapset. First, the mapset is comprised of "map data for two or more maps". Second, the mapset is "constructed prior to the servlet receiving the request". Appellants set forth numerous arguments in the Appeal Brief for both of these components.

With respect to the first component, page 6 of the Examiner's Answer asserts that Figure 5 of Berstis illustrates a mapset comprised of data for multiple maps. The Answer further provides that Figure 5 illustrates a map as well as a photographic image of a physical area of a location. The Answer continues and relies on the definition of a map set forth in MSN Encarta Dictionary and states that Bestis' photo in figure 5:

> clearly illustrates a geographic feature of roads and other details. Therefore, the photo is broadly interpreted as a map, and the combination of the photo and the map is interpreted as a "mapset".

As stated in the Appeal Brief, Phillips v. AWH provides that the specification and claims should be relied upon for the definition of the terms in the claims. The claims provide that the mapset is map data for one or more maps. Page 19, line 19-page 20, line 4 of the present specification provides:

> The map data 408 may also be referred to as a mapset. A mapset consists of: an initial map that is displayed when a mapset is selected; a set of maps based on the same MWF as the initial map that can be zoomed to sequentially from the initial map; and all maps that appear as links on the initial and zoomed maps. Further, each of the maps in a mapset contain data (such as object name, geometry, and the value of the link if an object has one) for every selectable object on the given map. The multiple maps of a mapset are necessary to provide zooming from the original map and also linking to other maps from the original and from any of the 'zoomed' maps.

As can be seen from the text of the present specification, the map data is specific such as object name, geometry, and the value of the link if an object has one. Further, the map data is for two or more maps. Thus, contrary to that asserted by the Patent Office, a photograph is not a map, map data, or a mapset, as used in the claims and specification of the present invention.

With respect to the second component, it is noted that since the claims provide that the mapset has two or more maps, and that the mapset itself is constructed prior to the servlet receiving a request for the mapset, the claims provide that the entire mapset (including the map data for two or more maps) is constructed prior to the servlet receiving the request.

It is also noted that the whole claim and the context of the claim must be considered when applying the prior art. In this regard, the claims provide for a PDA requesting the data via a servlet

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and receiving the mapdata from the servlet in the PDA. The context of such a claim clearly indicates that the information is not transmitted on a CD or merely stored on a server.

With the above express claim limitations in mind, Appellants address the further assertions by the Patent Office. The Patent Office asserts that maps such as a photographic image may be downloaded from a server or pre-recorded on a storage medium. The Office further asserts:

> The fact that the contents are prerecorded and can be downloaded clearly implies that these images are created prior to the PDA requesting the data.

Appellants respectfully disagree and traverse the above assertions. For purposes of argument, let us assume that the photograph meets the limitations of map data (which Appellants traverse as set forth above). The mere downloading of a single photo completely fails to teach the transmission of a mapset. Again, if the photo is a map, the mapset must consist of the photo and another map (since the claims explicitly require a mapset consisting of map data for two or more maps). The downloading of a single photograph apart and separate from any other maps and not as part of a mapset fails to meet the claim limitations. Bersits clearly describes the separate transmission of the photo from the other information as described in the Appeal Brief. Accordingly, it is impossible for Bersits to teach, disclose, or suggest, implicitly or explicitly, the single mapset comprised of data for multiple maps being received into a PDA.

The Answer continues and assets that the claims fail to recite the feature of a combined mapset. Appellants respectfully disagree and traverse such a statement. The claims explicitly provide the following limitation:

> "receive the map data in a mapset constructed prior to the servlet receiving the request, wherein the mapset comprises map data for two or more maps."

Thus, the claims provide that the map data is received in a mapset. Further, the mapset comprises map data for two or more maps. Further, the mapset is constructed prior to the servlet receiving the request for the map data. All of these limitations clearly establish that the mapset itself (which explicitly includes map data for two or more maps) is constructed prior to receiving a request from a PDA. The fact that the word "combined" is not present in the claims is completely irrelevant. The fact remains that the claims provide that the map data is received in the mapset (that contains map data for two or more maps) and the mapset itself is constructed prior to the servlet

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receiving the request. Accordingly, the assertions set forth by the Patent Office are wholly without merit.

Again, the present claims must be viewed as a whole and without ignoring all of the specific claim limitations. In this regard, a mapset is constructed prior to receiving a request for any map data. The mapset is constructed by a servlet and is composed of map data for two or more maps. Thereafter, a PDA transmits a request for mapdata and receives the previously constructed mapset in response. Accordingly, while the request is for mapdata, a mapset containing the mapdata is returned (and not necessarily only the map data specified in the request). The PDA formats the map data and displays it on the screen of the PDA. These unique combination of elements is not even remotely hinted at in Berstis.

Unlike the claim limitations, Berstis falls within the known prior art where data is stored on a server and instead of providing the ability to send a preconstructed set of data to a PDA upon request, once a request is received in Berstis, the data is gathered and sent over. Such a teaching (which comprises a teaching away from the present invention) is explicit in Berstis. Col. 5, line 66-col. 6, line 14 describes Fig. 5 of Berstis and provides:

> When the vehicle reaches a selected distance (or time) away from intersection 90, a display function in the device is invoked to fetch a photographic image 92 of intersection 90 depicting the impending scene. This image is then displayed as shown in FIG. 5. The graphical image 92 in this example provides aid to the driver of the vehicle by allowing him or her to see landmarks, such as water tower 94 and tree 96, at the critical location 90 in their natural perspective. The image may be of any convenient format (e.g., .jpeg, gif, .png. or the like) that may be readily transmitted (if required), stored and displayed. In an illustrative embodiment, the image is displayed in a pop-up window 93 on graphical display 12. Preferably, the window is generated by the device's browser. Alternatively, if the device does not include a browser, a separate window may be created by the device's operating system.

As can be seen from this text, the photographic image 92 is fetched separately from the map displayed. Such a separate fetching teaches away from a single mapset that is both (1) received as one unit by the PDA and (2) constructed prior to the servlet receiving a request. Instead, the map displayed on the device and later, the photographic image is fetched and displayed. The next paragraph of Berstis further describes the separation of the photo from the map (see col. 6, lines 15-30):

> In accordance with the present invention, the photographic image is preferably as close as possible to the real-time conditions that the driver is encountering during the drive. Thus, for example, if the driver is approaching the location at night, or during the Winter months, the photograph displayed represents the most accurate representation of the physical area. In this way, the

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device provides the user with both a graphical representation or navigation map, together with an actual representation of what physical landmarks are coming into the user's field of vision. If desired, the graphical display may provide other reference aids, such as display graphics (such as arrows and pointers) or the like, to further assist the user to navigate to the desired location. Alternatively, the display system may generate a voice-over (e.g., using a text-to-speech processor) that generates an audio cue.

In view of the above, it can be clearly seen that Berstis fails to teach the invention as claimed. Further, the Patent Office is attempting to assert a description of Berstis that is beyond the scope and intent of Berstis. Appellants submit that such an interpretation is without merit. Accordingly, Appellants request reversal of the Examiner's rejections.

B.   Dependent claims 12, 24, and 36

Appellants respectfully traverse the assertions set forth by the Patent Office with respect to these dependent claims.

In response to the prior arguments, the Patent Office provides a web definition from foldoc.org for a servlet. However, as noted, the definition does not provide nor specify the use of a GET HTTP request whatsoever. Appellants note that an HTTP request provides for various components. For example, a request message from a client to a server includes, within the first line of that message, the method to be applied to a particular resource, the identifier of the resource, and the protocol version in use. Various methods may be specified including options, head, post, delete, trace, and connect. None of these variations including a GET request or a PUT request are disclosed or described, implicitly or explicitly by Berstis. Such a teaching is notoriously absent from Berstis.

In addition to the above, it is noted that the claimed GET request is for map data and in response, rather than returning the map data itself, a mapset is returned and received by the PDA. Berstis fails to teach such a use of an HTTP GET request.

Again, the Patent Office is relying on elements that are allegedly well known in the art but repeatedly refuses to provide support for its assertions.

C.   Independent Claims 41, 45, and 49

In response to the Appellants Appeal Brief, the Patent Office elected to formally address the claim limitations set forth in these dependent claims.

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Specifically, the Patent Office provided that although the limitations were not explicitly taught, it would have been a matter of design choice and one of ordinary skill in the art could easily construct a mapset in parallel on multiple CPU's without involving the inventive concept and without producing an unexpected result, which would have been an obvious matter of choice.

Appellants respectfully disagree with and traverse such an assertion. Not only does Berstis fail to describe constructing a mapset in parallel on multiple CPUs, but Berstis completely fails to even remotely hint at such a teaching. In this regard, the Examiner is relying on her own knowledge without any support whatsoever for providing that it would be a design choice. Such an assertion is without merit and improper. Under MPEP §2142 and 2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Patent Office has failed to describe the claimed limitations in the prior art.

It is not Appellants obligation to disprove that a reference has or does not have any characteristics. Instead, under MPEP 2143, it is the Examiner's obligation to set forth a prima facie case of obviousness. As part of establishing the case, the Examiner must meet three criteria: he must show that some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Patent Office has failed to meet its obligation and failed to set forth a prima facie case of obviousness. In this regard, the Examiner has completely fails to provide any prior art reference that teaches the claimed limitations. Further, the Examiner has completely failed to provide any reasonable expectation of success that is not based on Appellant's disclosure.

In addition, Appellants submit that the use of multiple processing units that construct a mapset in parallel is not a matter of design choice and is not an obvious matter of choice. There are strategic advantages for performing such a construction that were discovered and addressed by the

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present inventors. In this regard, the Patent Office is relying on impermissible hindsight vision afforded by the claimed invention, which is improper under MPEP §2141.01.

In view of the above, Appellants respectfully request reversal of the Examiner's rejections.

D.   Conclusion

In light of the above arguments, Appellants respectfully submit that the cited references do not anticipate nor render obvious the claimed invention. More specifically, Appellants' claims recite novel physical features which patentably distinguish over any and all references under 35 U.S.C. §§ 102 and 103. As a result, a decision by the Board of Patent Appeals and Interferences reversing the Examiner and directing allowance of the pending claims in the subject application is respectfully solicited.
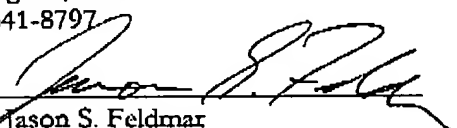
Respectfully submitted,

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